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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,012

03/16/2004

Ivan To

THOLAM P226US

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EXAMINER

SHARP, JEFFREY ANDREW

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

05/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/803,012

Applicant(s)

TO, IVAN

Examiner

Jeffrey Sharp

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3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

[1] This action is responsive to Applicant's request for continued examination filed on 28 February 2007 with regard to the Advisory Office action mailed on 23 January 2007.

#### *Status of Claims*

[2] Claims 10 and 15 remain pending.

#### *Claim Rejections - 35 USC § 102*

[3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claim 10 stands rejected under 35 U.S.C. 102(b) as being anticipated by Danjell US-5,232,388.

In short, and when the claims are given their broadest reasonable interpretation, Danjell generally discloses the invention as claimed, teaching a luminescent signage component comprising a one piece body (12) in the form of a sign plate having a first face (13) and a second face (11), at least one cavity (not labeled but shown in cross-section), said cavity defining alpha-

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numeric/graphic indicia, the at least one cavity being closed by an integrally formed transparent window (2) positioned across the second face (11). Luminescent epoxy (20) fills the at least one cavity such that the alpha-numeric or graphic indicia (herein "GLOW" or "COSMETICS") emits a luminescent glow.

***Response to Arguments/Remarks***

[5] Claim(s) 10 was previously rejected under 35 U.S.C. 102(b) as being anticipated by Danjell US-5,232,388.

Applicant's arguments/remarks with regard to this rejection have been fully considered, but are not persuasive.

After further consideration of the prior art and claim amendment filed on 28 February 2007, the examiner feels that claim 10 as amended still reads on the Danjell US-5,232,388 reference as discussed in detail above.

***New Grounds of Rejection***

***Claim Rejections - 35 USC § 112***

[6] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[7] Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "the sign plate being backlit by the light" is not definite. Is the plate

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translucent or transparent so as to be "backlit" by a light source, or is it just the cavity which is backlit so as to display a glowing alpha-numeric indicia? This limitation has been interpreted as: the sign plate itself not being lit, but rather only the cavity filled with luminescent epoxy is backlit by the light.

***Claim Rejections - 35 USC § 103***

[8] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[9] Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danjell US-5,232,388 in view of either Logan, Jr. et al. US-4,466,208 or Prgel et al. US-3,780,462.

In short, and when the claims are given their broadest reasonable interpretation, Danjell generally discloses the invention as claimed, teaching a sign comprising a sign enclosure (17-19), a light (15) mounted in said enclosure (17-19), a one piece sign plate (12) having a first face (13) and a second face (11), at least one cavity (not labeled but shown in cross-section), said cavity defining alpha-numeric/graphic indicia, the at least one cavity being closed by an integrally formed transparent window (2) positioned across the second face (11). Luminescent epoxy (20) fills the at least one cavity such that the alpha-numeric or graphic indicia emits a luminescent glow. The sign (12) is "backlit" at (16) by the light (15), and activates the luminescent material (20) so as to have the letters emit a luminescent glow.

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However, Danjell fails to disclose the alpha-numeric indicia comprising the word "EXIT".

Both Logan, Jr. et al. and Prgel et al., as well as the old and well-known, suggests luminescent signs comprising the word "EXIT" thereon/therein.

It would have been obvious to those of ordinary skill in the art, at the time the invention was made, to modify the alpha-numeric indicia on the luminescent sign taught by Danjell, to comprise the word "EXIT", in order to make advantageous use of Danjell's invention in hallways, amphitheatres, office buildings, and the like.

Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In the instant case, while Danjell utilizes his invention as a display for cosmetics and discloses the word "GLOW" as an example embodiment, Danjell would not have discredited his invention for use as an exit sign.

Note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In the instant case, the shapes and ornamentation of cavities provide no "mechanical" difference in function. Therefore, modifying the indicia cavities taught by Danjell would have been obvious to one of ordinary skill in the art.

USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10.

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However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004). In the instant case, the Examiner takes the position that merely changing the printed matter (herein, indicia formed by cavities) does not create an unobvious "functional" relationship between the printed matter and the substrate. In other words the change in cavity shape does not change the function of how the indicia is backlit.

### *Conclusion*

[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Sharp whose telephone number is (571) 272-7074. The examiner can normally be reached 7:00 am - 5:30 pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J.S.



**Katherine Mitchell**  
Primary Examiner